

## **REMARKS**

The present response is intended to be fully responsive to all points of rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application is respectfully requested.

### **1. Specification**

The Examiner objected to the abstract of the disclosure because of a sentence problem. Applicant has corrected the sentence problem so that a fragment identified by the Examiner makes sense.

The Examiner also objected to various informalities in the disclosure. The various informalities have been corrected in accordance with the Examiner's suggestions.

### **2. Claims**

Applicant has amended claims 1, 4, 14, 16, and 23, and canceled claim 25. Applicant has also added claims 26 and 27, which include the limitation of previously pending claims 13 and 23. Now pending in this application are claims 1-24, 26-27.

### **3. Drawings**

The Examiner objected to Figure 3 because element 322 was shown but not described. Applicant includes, as an appendix to this response, a replacement sheet and an annotated sheet with corrections showing that reference to element 322 in Figure 3 has been removed.

### **4. Response to Anticipation Rejection**

The Examiner has rejected claims 1-4, 6-7, 15-16, and 24 under 35 U.S.C. § 102(e) as being anticipated by Kennedy (U.S. Patent No. 6,377,825). Applicant respectfully traverses this rejection.

Applicant has amended claims 1 and 16 to distinctly claim processing performed by a control system coupled externally to a subscriber terminal. The control system has a controller and an actuator. The controller receives an actuation signal provided in response to a human actuating the actuator, and the controller receives an indication of a status of the subscriber terminal. If the status is a first status, then, in response to the indication of status and the actuation signal, the controller determines a first action to be taken by the subscriber terminal and sends a first directive to the subscriber terminal indicating the first action to be taken. Alternatively, if the status is a second status, then, in response to the indication of status and the actuation signal, the controller determines a second action to be taken by the subscriber terminal and sends a second directive to the subscriber terminal indicating the second action to be taken. The subscriber terminal then takes the indicated action.

As recited by the claims, the first status is different than the second status, the first action is different than the second action, and the first directive is different than the second directive. In this regard, if the subscriber terminal has a status of "currently engaged in a call", for instance, the action may be for the subscriber terminal to dial "end" and the directive might cause the subscriber terminal to disconnect the call in progress. Alternatively, if the subscriber terminal has a status of "currently ringing", for instance, the action may be for the subscriber terminal to dial "talk" and the directive might cause the subscriber terminal to answer an incoming call. Still alternatively, if the subscriber terminal has a status of "powered on", for instance, the action may be for the subscriber terminal to dial a number or feature code to a VAD server and the directive might cause the subscriber terminal to be connected to the VAD server.

In order for a reference to anticipate a claimed invention, the reference must teach each and every element of the claimed invention. (MPEP § 2131). The Examiner cites Kennedy as

anticipating the claimed invention. The Examiner correctly points out that Kennedy discloses an interface module coupled externally to a telephone. The interface module receives a signal in the form of a spoken command, determines that the status of the telephone is "on-hook" (in which case the interface module enters a voice recognition mode), and sends a command to the telephone to dial a telephone number. Applicant submits, however, that Kennedy does not disclose determining alternative statuses of the subscriber terminal, and generating and sending alternative directives to the subscriber terminal corresponding to the alternative statuses. Kennedy discloses that the interface module determines a single status of the telephone, i.e., telephone is "on-hook" and sends to the telephone a single directive, i.e., to dial a telephone number. But if the status of the telephone is different, Kennedy does not disclose that the interface module would generate or send another, different, directive to the subscriber terminal than dialing a telephone number. The interface module would likely not generate or send any directive to the telephone when the telephone is not "on-hook." Therefore, Kennedy does not disclose determining a first and second status of the subscriber terminal and sending a corresponding first or second directive to the subscriber terminal, as claimed by claims 1 and 16.

Applicant recognizes that the interface module in Kennedy could be provided with "barge-in" capability. Kennedy states that the "barge-in" capability results in the interface module entering into voice recognition mode "even while a telephone call is in progress (i.e., the telephone is off-hook)." (Col. 19, lines 16-17). Applicant infers from this disclosure that the interface module enters into the voice recognition mode regardless of the status of the telephone, so there is no need for the interface module to determine the status of the telephone. Even if Kennedy was to disclose determining alternative statuses of the subscriber terminal in a "barge-in" mode (status is "on-hook" or "off-hook"), the directive generated and sent to the telephone is

no different than if the telephone is "on-hook." The directive is still to dial a telephone number, so Kennedy still does not disclose determining a first and second status of the subscriber terminal and sending a corresponding first or second directive to the subscriber terminal, as claimed by claims 1 and 16.

Claims 2-4, 6-7, 15, and 24 depend on amended claims 1 and 16. As Kennedy fails to anticipate the invention claimed by claims 1 and 16, Kennedy necessarily fails to anticipate the invention claimed by claims 1-4, 6-7, 15-16, and 24.

## **5. Response to Obviousness Rejection**

### **(i) Claims 8, 10, 13, 17, 19, 22 and 25**

Claims 8, 10, 13, 17, 19, and 22 depend on claims 1 or 16. The Examiner has rejected claims 8, 10, 13, 17, 19, 22, and 25 under 35 U.S.C. § 103(a) as being unpatentable over Kennedy in view of Kravitz (U.S. Patent No. 6,035,217).

Kravitz discloses a one button cellular phone. The one button cellular phone provides basic phone functions using a single button on the phone. The single button may be used to call a service provider, so that a user can speak a desired number to call and the service provider can connect the one button cellular phone to the desired number. Also, the single button may be used to answer an incoming call and terminate a call in progress.

For the reasons discussed above, Kennedy does not anticipate claims 1 and 16. Moreover, Applicant submits that Kravitz does not make up for the deficiency of Kennedy. Kravitz does not disclose or suggest in any way that the user interface module of Kennedy (i) generates a first directive indicative of a first action and send the first directive to the subscriber terminal, if the status of the subscriber terminal is a first status, terminal, and (ii) generates a second directive indicative of the second action and send the second directive indicative of the

second action to the subscriber terminal, if the status of the subscriber terminal is a second status. Instead, Kravitz discloses that the one button cellular phone, itself, performs certain actions based on its status and actuation of the one button, and does not teach or suggest that the interface module of Kennedy generates or sends different directives corresponding to different statuses of the subscriber terminal. Therefore, the combination of Kennedy and Kravitz does not teach or suggest the routines performed by a controller in claims 1 and 16.

In order to establish a prima facie case of obviousness, a proposed combination of references must teach or suggest all of the elements of the claimed invention. (MPEP § 2143). The invention claimed by claims 1 and 16 are novel in view of Kennedy and Kravitz because Kravitz does not make up for the deficiency in Kennedy. As claims 8, 10, 13, 17, 19, and 22 depend on claims 1 or 16, Applicant submits that the combination of Kennedy and Kravitz cannot render the invention claimed by claims 8, 10, 13, 17, 19, and 22 obvious.

**(ii) Claims 5, 9, 11-12, 18, 20-21**

Claims 5, 9, 11-12, 18, 20-21 also depend on claims 1 or 16. The Examiner has rejected claims 5, 9, 11-12, 18, 20-21 under 35 U.S.C. § 103(a) as being unpatentable over a combination of Kennedy and Kunihiro (U.S. Patent No. 5,915,288), a combination of Kennedy, Kravitz, and Maloney (U.S. Patent No. 6,453,169), or a combination of Kennedy, Kravitz, and Kirbas (U.S. Patent No. 6,449,497). Applicant submits that Kunihiro, Maloney and/or Kirbas do not make up for the deficiencies in Kennedy. Kunihiro discloses an information input method, Maloney discloses a radiotelephone with multiple function power key, and Kirbas discloses feature codes. Therefore, the combinations cited by the Examiner cannot render the invention claimed by claims 5, 9, 11-12, 18, 20-21 obvious.

**6. Allowance of Claims 14 and 23**

The Examiner has allowed claims 14 and 23, if rewritten in independent form including all limitations of the base claim and intervening claims. Applicant thanks the Examiner, and rewrites claims 14 and 23 in independent form including all limitations of the base claim and intervening claims. Therefore, Applicant respectfully requests allowance of claims 14 and 23. New claims 26 and 27, added by the Applicant, include the limitations of previously pending claims 14 and 23.

**Conclusion**

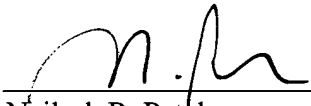
In summary, Applicant respectfully submits that each of the pending claims is allowable and therefore respectfully requests favorable reconsideration.

Respectfully submitted,

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HULBERT & BERGHOFF**

Date: October 16, 2003

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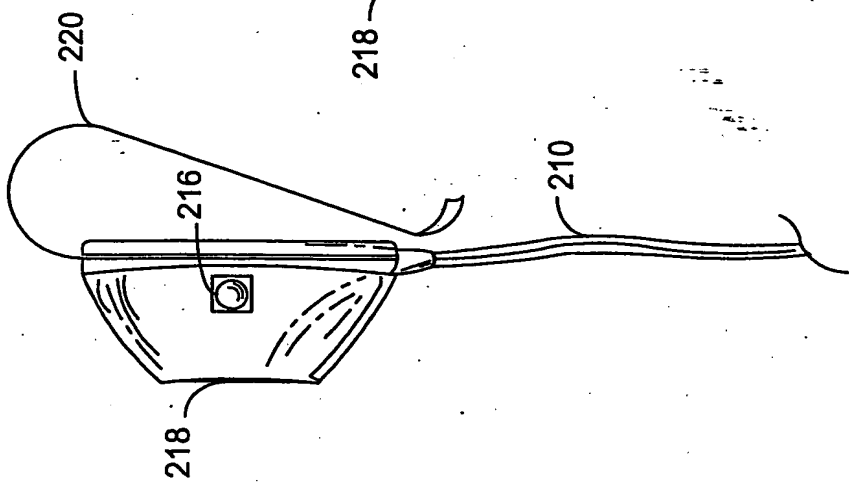


FIG. 2B

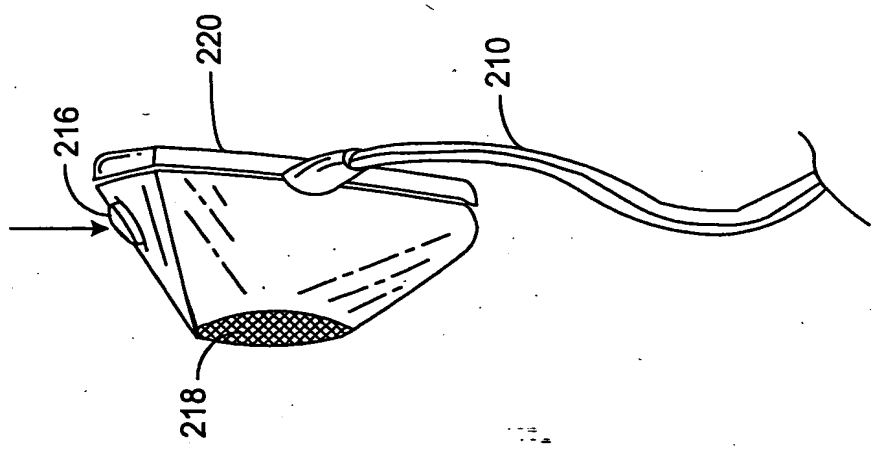


FIG. 2C

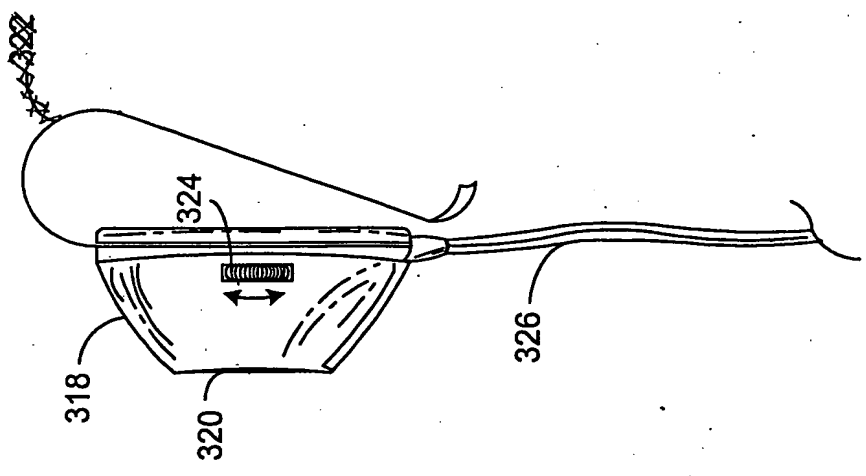


FIG. 3